



AF/3700

Docket No. 4481-028

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TECHNOLOGY CENTER R3700

In re Application of
Bernhard DEHMER
Serial No. 09/672,038
Filed: September 29, 2000
For: VALVE FOR LIQUID SEPARATION

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: Group Art Unit: 3753
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: Examiner: J. Fox
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PETITIONS TO THE COMMISSIONER
TO (1) WITHDRAW FINALITY OF PREMATURE FINAL REJECTION
AND (2) TO WITHDRAW RESTRICTION REQUIREMENT

Honorable Commissioner of
Patents and Trademarks
Washington, DC 20231

Sir:

Applicants petition the Commissioner to have the finality of the November 12, 2002, final rejection withdrawn.

FACTS

On January 28, 2002, the Examiner issued an initial final rejection of all claims of the referenced application, based on 35 USC 112, paragraph 2. Applicant filed an April 29, 2002, response, pointing out why the Examiner was incorrect. The response included an amendment to claim 15, which added the word "and." While the amendment after final rejection was entered; the Examiner refused to allow any claims, based on the argument applicant submitted.

On July 29, 2002, applicant submitted an Appeal Brief challenging the rejection of all pending claims under 35 USC 112, paragraph 2.

The Examiner replied to the Appeal Brief by issuing a November 12, 2002, final rejection. The November 12, 2002, final rejection includes:

1. An objection to a substitute specification filed December 13, 2001, because the substitute specification contains new matter;
2. A restriction requirement between the claims of Group I (i.e., claims 2, 3, 5-11, 14-16, 39-48, 22-28 and 32-38) and Group II (i.e., claims 17-21 and 29-31);
3. A rejection of claims 23, 5-11, 14-16, 39-48, 22-28 and 32-38 under 35 USC 112, paragraph 2 (the rejection under 35 USC 112, paragraph 2, in the November 12, 2002, final rejection is on grounds different from the reasons for final rejection set forth in the initial January 28, 2002, final rejection);
4. A rejection of claims 22-28 and 32-38 under 35 USC 112, paragraph 1;
5. A rejection of claims 15, 2, 3, 5-8 and 14 under 35 USC 102(b) as being anticipated by a newly cited reference, namely Brown, U.S. Patent 2,542,390; and
6. A rejection of claims 16, 39-42, 47 and 48 under 35 USC 103 as being unpatentable over DE 195 09 145, of record, in view of EP 0 907 045, of record (neither of the '145 or '045 references had ever been applied against any of the claims).

The Examiner alleges that applicant's amendment adding the word "and" to claim 15 necessitated the new grounds of rejection.

ARGUMENT

A. The premature final rejection

As pointed out in MPEP §706.07(c), this petition to withdraw the final rejection is necessary because "Any question as to prematurity of a final rejection should be raised, if at all,

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while the application is still pending before the primary Examiner." Hence, if the issue of the prematureness of the final rejection is not raised now, applicants have no other opportunity to raise the issue.

As pointed out in MPEP §706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR 1.97(c)....Furthermore, a second or any subsequent action on the merits in any application...will not be made final if it includes a rejection, on newly cited art, other than information submitted in an Information Disclosure Statement filed under 37 CFR 1.97(c)...of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

The foregoing provisions are consistent with the statements in MPEP §706.07, which are as follows:

Before final rejection is in order a clear issue should be developed between the examiner and applicant...present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application....The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing and that a clear issue between the applicant and the examiner should be developed, if possible, before appeal....In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

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In the present case, the Examiner, in making the action final, has clearly violated the foregoing principles. Making the rejection final, based on a reference that was first cited after submission of an Appeal Brief, does not give applicant any opportunity to amend the claims and consider alternative language which could overcome the basis of rejection. The Examiner is attempting to prematurely cut off prosecution of this application and is not providing applicants with a full and fair hearing.

The Examiner has lost sight of the fact that in every case the applicant is entitled to a full and fair hearing and that a clear issue between the applicant and the Examiner should be developed, if possible, before appeal. The Examiner has not permitted development of a clear issue.

The rejection based on 35 USC 112, paragraph 2, is entirely different from the previous rejection on this statutory provision. The previous rejection on 35 USC 112, paragraph 2, is not repeated in the November 12, 2002, Office Action, and appears to be withdrawn. Because the Examiner makes no comments about the addition of "and" to claim 15, that amendment could not have necessitated the new 35 USC 112, paragraph 2, rejection.

There was never a prior rejection based on 35 USC 112, paragraph 1. It is clearly incorrect for the Examiner to state that applicant's amendment adding the word "and" to claim 15 necessitated a new ground of rejection of claims 22-28 and 32-38

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under 35 USC 112, paragraph 1 or a new ground of rejection of claims 15, 2, 3, 5-8 and 14 as being anticipated by a newly cited reference. The Examiner's position that the addition of the word "and" to claim 15 resulted in a new ground of rejection of claims 16, 39-42 and 47 and 48 based on obviousness.

It is impossible for applicant to be entitled to a full and fair hearing, when a restriction requirement has been entered simultaneously with a final rejection. This is particularly true when the Examiner previously considered all the claims in this application. The Examiner says the applicant made a tentative election of the claims of Group I by submitting the new claims of Group II. However, the claims of Group II which were not considered in the November 12, 2002, Office Action were filed in the December 13, 2001, amendment. Since then, the Examiner issued a final rejection, the applicant amended claim 15, the Examiner issued an Advisory Action, applicant appealed and filed an Appeal Brief, directed, *inter alia*, to the claims of Group II. On this basis, the Examiner cannot properly say that the claims of Group II are "new" claims.

B. The restriction requirement is wrong

The restriction requirement is improper because it is not timely. Issuing a final rejection while making a restriction requirement is contrary to 37 CFR 1.142(a), which says:

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office

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action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time *before final* action. (emphasis added)

MPEP §811 also says:

...the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

The Examiner has violated both of these tenets.

The Examiner appears to have ignored the requirement in MPEP §810 that:

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

The restriction requirement is thus untimely because it is after appeal and with a final rejection. The requirement is a burden on applicant because it delays issuance of a patent on the features of the claims of Group II. Withdrawal of the requirement is thus in order.

Based on the foregoing, the finality of the November 12, 2002, Office Action and the restriction requirement accompanying the Office Action were clearly incorrect and must be withdrawn.

Based on the foregoing, granting of the Petitions is in order. If, however, the Petitions are not granted, the Office is

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authorized to charge the petition fee to the deposit account of attorney for applicant, account number 07-1377.

Respectfully submitted,

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